

REMARKS

Claims 1-20, 23-36, and 38 are pending in the application. Claims 1-10 and 13-15 are rejected under § 102(b). Claims 11-12 are rejected under § 103(a).

Claims 16-20, 23-36 and 38 are indicated as being allowed.

§ 102(b) REJECTIONS

The rejection of claims 1-10 and 13-15 under § 102(b) as anticipated by Sherman et al. has been maintained, and made final.

The Examiner characterizes Sherman et al. as follows (emphasis added):

Sherman et al disclose an apparatus for attaching a conduit to a vessel including an enclosure 12 with a port 76 for evacuating air therefrom, a tool 116 with a holding member 117, a conduit 14, **a ring or "attachment portion" or "sewing cuff" 26 separable from enclosure 12** (Figures 4, 12, 16A and 16B, col. 1, lines 13-19, col. 8, lines 25-31 and lines 54-66, col. 9, lines 53-67, col. 10, lines 1-18, col. 13, lines 42-67, col. 14, lines 1-2, col. 16, lines 37-48, and co. 17, lines 21-65.)

In response to remarks made by the Applicant in the previous Amendment, the Examiner provided the following comments, at page 2 of the Office Action:

The limitation, "separable from a remainder attached thereto," requires that the attachment portion be capable of being separated from the remainder of the enclosure and does not require that the attachment portion be separated from the enclosure.

The limitation, "conduit is attachable to via said attachment portion," does not require a physical connection between the conduit and the attachment portion.

Claim 1, as amended herein, reads as follows (emphasis added):

1. An apparatus for attaching a conduit to at least one of a heart and a blood vessel, said apparatus comprising:

- a. an enclosure having an attachment portion adapted for attachment to a wall of said heart or blood vessel, said attachment portion separable from a remainder of said enclosure such that said attachment portion remains attached to said wall of said heart or blood vessel once attached thereto;
- b. a tool having a first portion for creating an opening through said wall, said first portion contained within said enclosure; and
- c. a conduit having a first end attachable to said attachment portion, said first end contained within said enclosure, wherein said first end of said conduit is secured in said opening through said wall of said heart or blood vessel by said attachment portion.

Part (a) requires at least-

- an "attachment portion" which is "adapted for attachment to" the wall of the heart; **and**
- that the "attachment portion" remains attached to the wall of the heart once attached thereto.

Part (c) requires at least-

- that the first end of the conduit is attachable to said attachment portion; **and**
- that the end of the conduit is secured in the opening through said wall of the heart by the attachment portion.

All four of the preceding limitations are particularly recited in claim 1.

1. The Examiner states that "separable from" means only "capable of being separated from." Even if that is true, part (a) of claim 1 still includes two additional limitations which the Examiner does not appear to have considered.

Specifically, the rack 26 is not "adapted for attachment to" the heart wall and the rack 26 certainly does not remain attached to the heart wall.

2. The recitation in claim 1 that "said first end of said conduit is attachable to said wall of said heart or blood vessel via said attachment portion" may not require a physical

connection between the conduit and the attachment portion. However, even though claim 1 is amended herein to slightly change this recitation, part (c) has always required that the first end of the conduit is attachable to the attachment portion. This limitation is not disclosed in Sherman et al.

As amended the last sentence in part (c) now more particularly recites that the end of the conduit is secured in the opening through the wall of the heart by the attachment portion.

In Sherman et al. the end of the conduit is never attached to the rack 26. The rack also 26 does not secure the end of the conduit in the opening through the wall of the heart. Sherman et al. describe that the end of the conduit is secured in the opening through the heart wall by sutures applied to the heart wall by the "needle advancing mechanism."

3. In order for a rejection under § 102(b) to be proper, every limitation of claim 1 must be disclosed, or inherent, in the single prior art reference. Sherman et al. does not disclose (and it is not inherent therein) at least the following limitations:

1. that the attachment portion (rack 26) is adapted for attachment to the heart wall;
2. that the attachment portion (rack 26) remains attached to the heart wall;
3. that the end of the conduit is attached to the attachment portion (rack 26); and
4. that the end of the conduit is secured in the opening through the heart wall by the attachment portion (rack 26).

Claim 1, as amended, specifically requires all of these limitations. Therefore, even if the comments by the Examiner were correct, the four limitations listed above are not disclosed or inherent in Sherman et al. The first three listed limitations were part of claim 1 even before this Amendment (and the last listed limitation has only been clarified by this Amendment).

The rack 26 described in Sherman et al. is not described as being in any way "attachable to" the heart wall. It is not possible that the rack 26 could ever be "attached to" the heart. The rack 26 assists in the application of sutures to the heart wall. The end of the cannula is secured in the opening in the heart wall by the sutures, not by the rack 26. The end of the cannula is never attached to the rack 26. The sutures do not attach the rack 26 to either the heart wall or to the end of the cannula. To otherwise characterize Sherman et al. in this way would be contrary to the way the device is described in the patent. It is impossible for the rack 26 to ever be attached to the end of the cannula or to the heart wall based upon the description in the patent of how the suture applying device operates.

Finally, the rack 26 is not truly "capable of being separated" from the tubular member 14 within the meaning of claim 1. Claim 1 requires that the attachment portion is not only "adapted for attachment to," but that it also thereafter remains attached to, the heart wall. This is impossible with the device in Sherman et al. If the rack 26 were ever "separated from" the tubular member 14, then the device would cease to operate -- it would be incapable of performing the intended function as described in the patent. Thus, even if it is theoretically possible to separate the rack 26 from the tubular member 14, to do so would be contrary to the way the patent describes the device and how it operates.

Therefore, and at least because Sherman et al. does not disclose any of the four limitations listed above, claim 1 is not anticipated by Sherman et al.

§ 103(a) REJECTIONS

Claims 11-12 are rejected under § 103(a) as unpatentable for being obvious over Sherman in view of Leahy et al. '409 ("Leahy"). Claims 11 and 12 depend ultimately from claim 1, and are believed patentable because claim 1 is believed patentable, for the reasons given above.

ALLOWED CLAIMS

Claims 16-20, 23-36 and 38 are indicated as being allowed.

CONCLUSIONS

Amended claim 1 requires at least the following limitations:

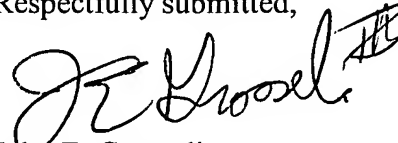
1. that the attachment portion (rack 26) is adapted for attachment to the heart wall;
2. that the attachment portion (rack 26) remains attached to the heart wall;
3. that the end of the conduit is attached to the attachment portion (rack 26); and
4. that the end of the conduit is secured in the opening through the heart wall by the attachment portion (rack 26).

These limitations are not disclosed, inherent, or taught by Sherman et al., or any of the prior art record.

Application No. 10/047,507
Amendment dated March 1, 2005
Reply to Office Action of December 15, 2004

Therefore, amended claims 1 through 15 are believed to be patentable over Sherman et al., and all of the prior art of record. Accordingly, reconsideration and allowance of claims 1 through 15 are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J E Grosselin", with a stylized flourish at the end.

John E. Grosselin
Registration No. 38,478
BUCHANAN INGERSOLL
PROFESSIONAL CORPORATION
One Oxford Centre, 20th Floor
301 Grant Street
Pittsburgh, PA 15219-1410
Attorneys for Applicant

412-562-1370